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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,381	11/14/2003	Marc C. Albertsen	0578RC-US	1318
7590	05/05/2006		EXAMINER	
Patricia A. Sweeney 1835 Pleasant St. West Des Moines, IA 50264			IBRAHIM, MEDINA AHMED	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/713,381	ALBERTSEN ET AL.
	Examiner	Art Unit
	Medina A. Ibrahim	1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(h).

## Status

1)  Responsive to communication(s) filed on 10 February 2006.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 23-42 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 23-42 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's response filed 02/10/06 in reply to the Office action of 10/21/05 has been entered. Claims 23-27, 30, and 41 have been amended. Claims 23-42 are pending.

This Office action contains NEW GROUNDS OF REJECTIONS and is made non-final. Any inconvenience the delay may have caused Applicant is deeply regretted.

Claims 23-42 are pending and are examined.

All previous objections and rejections not set forth below have been withdrawn in view of Applicant's amendment and/or upon further consideration.

#### ***Priority***

Applicant's claim for the benefit of the prior-filed application 09/504, 487 under 35 U.S.C. 120, as a continuation is acknowledged. However, this application adds and claims additional disclosure not presented in the prior application. For example, claims 23-26 recites sequences comprising regulatory regions (1 to 1311; 1155 to 1311; 1179 to 1208; and 1239 to 1278) of SEQ ID NO: 1 and 2 that are not present in the prior art application. Therefore, this application would constitute a CIP (continuation-in-part) of application 09/504, 487.

#### ***Claim Rejections - 35 USC § 102***

Claims 32, 38-39 and 41-42 are rejected under 35 U.S.C. 102(b) as being

anticipated by Cigan et al (US 5, 795, 753). This rejection is repeated for the reasons of record as set forth in the last Office action of 10/21/05. Applicant's arguments filed 01/03/06 have been considered but are not deemed persuasive.

Applicant argues that the claimed fragment of SEQ ID NO: 1 or 2 essential for regulatory activity is not anticipated by the anther-specific promoter taught by Cigan et al. Applicant asserts that the claimed fragment retains the function of SEQ ID NO: 1 or 2. Applicant, therefore, requests that the rejection be withdrawn.

These are not persuasive because the maize anther-specific promoter disclosed by Cigan et al inherently possesses regions essential for male-tissue regulatory activity; therefore, it would anticipate the claimed fragment of SEQ ID NO: 1 or 2 essential for regulatory activity. Applicant has provided no clear and convincing evidence showing how the claimed fragment distinguishes from the prior art promoter. Therefore, the rejection is proper.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23-42 are rejected on the ground of nonstatutory double patenting over claims 1-30 of U. S. Patent No. US 6, 037, 523 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: isolated male tissue-specific regulatory sequences comprising SEQ ID NO: 1 or 2 or a fragment thereof essential for regulatory activity, method of expressing exogenous nucleotide sequence encoding a protein that disrupts male tissue function using said isolated regulatory regions, and transgenic plant and plant cells comprising said male tissue regulatory sequences.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### **Remarks**

No claim is allowed.

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM . Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/26/06  
Mai

MEDINA A. IBRAHIM  
PRIMARY EXAMINER

